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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/088,138	11/25/2002	Saliha Moussaoui -Mrabet	ST99040 US PCT	1464

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EXAMINER
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FALK, ANNE MARIE

ART UNIT	PAPER NUMBER
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1632

NOTIFICATION DATE	DELIVERY MODE
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02/07/2008

ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

USPatent.E-Filing@sanofi-aventis.com  
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<p align="center"><b>Advisory Action</b> <b>Before the Filing of an Appeal Brief</b></p>	<p>Application No. 10/088,138</p>	<p>Applicant(s) MOUSSAOUI -MRABET ET AL.</p>	
	<p>Examiner Anne-Marie Falk, Ph.D.</p>	<p>Art Unit 1632</p>	

**--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

THE REPLY FILED 09 January 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☐ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☐ The period for reply expires \_\_\_\_\_ months from the mailing date of the final rejection.  
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**NOTICE OF APPEAL**

2. ☒ The Notice of Appeal was filed on 09 January 2008. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

**AMENDMENTS**

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because  
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);  
(b) ☐ They raise the issue of new matter (see NOTE below);  
(c) ☒ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or  
(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).  
5. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.  
6. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).  
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.  
The status of the claim(s) is (or will be) as follows:  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 1-10, 13, 15 and 16.  
Claim(s) withdrawn from consideration: \_\_\_\_\_.

**AFFIDAVIT OR OTHER EVIDENCE**

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).  
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).  
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

**REQUEST FOR RECONSIDERATION/OTHER**

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See Continuation Sheet.  
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s). \_\_\_\_\_.  
13. ☐ Other: \_\_\_\_\_.

  
**ANNE-MARIE FALK, PH.D**  
**PRIMARY EXAMINER**

Anne-Marie Falk, Ph.D.  
Primary Examiner  
Art Unit: 1632

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**Continuation Sheet (PTOL-303)****Continuation of 3: NOTE:**

The proposed amendment, if entered, would necessitate new grounds of rejection under 35 U.S.C. 112, second paragraph, for indefiniteness and for failing to properly further limit an independent claim. Independent Claim 16 requires that the animal comprise an M146L mutation in the murine presenilin 1 gene. The proposed amendment to Claim 5 recites the limitation that "the murine presenilin 1 gene comprising a M146L mutation is replaced by" one of the mutations selected from A246E, C410Y, H163R, L286V or L235P. However, when the M146L mutation is replaced by one of the recited mutations, the animal no longer comprises "a nucleic acid sequence encoding a mutation in the murine presenilin 1 gene comprising a M146L mutation" as set forth in Claim 16. Accordingly, Claim 5 would cover animals that fall outside the scope of Claim 16. A dependent claim must include all the limitations of the claim from which it depends. Here, the dependent claim does not properly further limit the independent claim as required. Therefore, if entered, the proposed amendment would necessitate a new ground of rejection under 35 U.S.C. 112, second paragraph.

**Continuation of 11.** The request for reconsideration has been considered but does NOT place the application in condition for allowance because:

At page 4 of the response, with regard to the rejection under 35 U.S.C. 102(b)/103, Applicants allege that Duff et al. does not provide any suggestion or motivation that would suggest to one skilled in the art to construct the transgenic model of the instant invention comprising amyloid plaques, neuronal loss, and mitochondrial dysfunction. However, when the structure disclosed in the prior art is substantially identical to that claimed, claimed properties are presumed inherent. MPEP § 2112(III) states that a rejection under 35 U.S.C. 102/103 can be made when the prior art product seems to be identical

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**Continuation Sheet (PTOL-303)**

except that the prior art is silent as to an inherent characteristic. Here, the prior art is silent with respect to mitochondrial dysfunction and neuronal death/loss.

The MPEP states that the “express, implicit, and inherent disclosures of a prior art reference may be relied upon in the rejection of claims under 35 U.S.C. 102 or 103.” MPEP § 2112. Also see the decision of *In re Napier*, 55 F.3d 610, 613, 34 USPQ2d 1782, 1784 (Fed. Cir. 1995) which states that “[t]he inherent teaching of a prior art reference, a question of fact, arises both in the context of anticipation and obviousness.” The MPEP further emphasizes that the “inherent feature need not be recognized at the time of the invention” (MPEP § 2112).

MPEP § 2112 explicitly states the following:

“SOMETHING WHICH IS OLD DOES NOT BECOME PATENTABLE UPON THE DISCOVERY OF A NEW PROPERTY

‘The discovery of a previously unappreciated property of a prior art composition, or of a scientific explanation for the prior art’s functioning, does not render the old composition patentably new to the discoverer.’ *Atlas Powder Co. v. Ireco Inc.*, 190 F.3d 1342, 1347, 51 USPQ2d 1943, 1947 (Fed. Cir. 1999). Thus, the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. *In re Best*, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977).”

The MPEP further teaches that “once a reference teaching product appearing to be substantially identical is made the basis of a rejection, and the examiner presents evidence or reasoning tending to show inherency, the burden shifts to the applicant to show an unobvious difference.” MPEP § 2112. In the instant case, no evidence has been presented to show that the prior art product does not necessarily or inherently possess the characteristics of the claimed animal.

In the decision of *In re Spada*, 15 USPQ2d 1655 (CAFC 1990) the court points out that discovery of a new property or use of a previously known composition, even if unobvious from prior art, cannot impart patentability to claims to known compositions. The transgenic animal claimed constitutes “a previously known composition.”

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**Continuation Sheet (PTOL-303)**

Applicants' arguments directed to the proposed claim amendments are moot, as the proposed amendment has not been entered for the reasons noted above.

Accordingly, the claims remain rejected, for reasons of record.